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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/349,105	07/08/99	RONDEAU C	05725.0441-0

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
1751	3

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/349,105	Applicant(s) Rondeau
	Examiner Caroline D. Liott	Group Art Unit 1751

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-55* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-55* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on 7/9/98. It is noted, however, that applicant has not filed a certified copy of the French application as required by 35 U.S.C. 119(b). Although it appears as though a certified copy of the foreign priority document was filed with the letter of 7/8/99, no certified copy is present in the instant application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 and 21-55 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No. 09/349,436. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application recite hair dyeing compositions, processes and kits which use a combination of cationic direct dyes and polymers. The cationic direct dyes and polymers of the copending application overlap in scope with those as claimed. The compositions of the copending application may also contain oxidation

bases, couplers and oxidants as claimed. Therefore, the copending claims obviate the instantly claimed invention.

Claims 1-55 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23, 31, 54-82, 84-87, 90-107 of copending Application No. 09/350,579. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application recite hair dyeing compositions, processes and kits which use a combination of cationic direct dyes and polymers. The cationic direct dyes and polymers of the copending application overlap in scope with those as claimed, e.g. the copending polymers include hydroxyalkylcellulose and guar gum derivatives. The compositions of the copending application may also contain oxidation bases, couplers and oxidants as claimed. Therefore, the copending claims obviate the instantly claimed invention.

Claims 1-21 and 25-55 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 and 17-42 of copending Application No. 09/287,176. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application recite hair dyeing compositions, processes and kits which use a combination of cationic direct dyes and polymers. The cationic direct dyes and polymers of the copending application overlap in scope with those as claimed, e.g. the copending polymers include cellulose derivatives. The

compositions of the copending application may also contain oxidation bases, couplers and oxidants as claimed. Therefore, the copending claims obviate the instantly claimed invention.

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

35 U.S.C. 112 Rejections

Claims 30-31, 42, 45-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 30 and 31 are indefinite because the claimed "direct dyes" and "azo dyes" are defined so broadly that the read on the claimed cationic direct dyes. A claim in which one ingredient is defined so broadly that it reads upon a second does not meet the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Ferm and Boynton*, 162 USPQ 504 (BdPatApp & Int 1969).

Claim 42 is indefinite for reciting that the claimed composition "is present in an amount sufficient for lightening dyeing direct dyeing" because it is unclear in what the composition is present. Furthermore, it is unclear what the term "lightening dyeing direct dyeing" means or encompasses. Clarification is required.

Claim 45 is indefinite for reciting "oxidation dyeing," but for not requiring any oxidative dyes or oxidants in the claimed compositions or methods. It is therefore unclear how oxidation occurs. Clarification is required.

Claims 45 and 48-51 are indefinite because the term "the desired coloration" lacks proper antecedent basis in the claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-17, 25-29, 32-34, 38-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Rondeau et al.

Rondeau, U.S. Patent No. 6,001,135, exemplifies a composition for dyeing keratin fibers which comprises three parts, see Example 2. The first part contains an oxidation base in the claimed amounts in an aqueous dyeing medium which has a pH as claimed due to the presence of ammonia, see Composition 2(A). The second part contains the cationic direct dye of formula (I1), and sawdust which comprises polymers containing a sugar unit as claimed (cellulose), see Composition 2(A'). The third part comprises the oxidant hydrogen peroxide, see composition (B). The compositions are mixed and applied to hair in a dyeing process as claimed, wherein the final mixture contains each claimed component in the claimed amounts. Rondeau, therefore, anticipates compositions and processes as claimed.

35 U.S.C. 103(a) Rejections

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rondeau.

Rondeau is relied upon above as exemplifying hair dyeing compositions and processes which use cationic direct dyes, oxidation bases, polymers and oxidants as claimed. The patentee more broadly teaches compositions which contain cationic dyes of formulae (I)-(III') in combination with an oxidation base, see col. 2, line 15-col. 21, line 13. The compositions may also contain couplers in the claimed amounts and additional direct dyes as claimed, see col. 21, line 60-col. 22, line 9. The composition may be applied in various processes, and may be packed in kits as claimed, see col. 22, line 53-col. 23, line 60. In col. 23, lines 24-30, Rondeau teaches the equivalence between the exemplified sawdust and various other sugar-unit containing polymers as claimed. Rondeau does not exemplify a composition which contains each claimed component in the claimed amounts, particularly the specifically claimed polymers. The patentee also does not specifically teach the various claimed hair dyeing processes and kits.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair which contains a cationic direct dye, oxidation base, coupler, oxidant and additional dyes as claimed, wherein each component is present in the

claimed amounts, wherein the composition may be applied to hair in processes as claimed and may be packaged in multi-part kits, because such compositions, processes and kits fall within the scope of those as taught by Rondeau. Particularly, it would have been obvious to those skilled in the art to substitute the sawdust excipient in Rondeau's Example 2 with a polymer as claimed, e.g. a cellulose or gum derivative, because the patentee teaches the equivalence between such excipients for use in the patentee's compositions. The Office holds the position that the various claimed processes and kits are obvious variants of Rondeau's processes and kits because the same end-results would be expected and obtained, i.e. the application of a cationic dye, oxidation base, polymer, and oxidant to the hair, absent a showing otherwise.

Claims 1-9, 12-17, 22-31, 42 and 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kao Corporation.

Kao Corporation, EP 756,861, teaches compositions for dyeing hair containing at least one direct dye, and a C_{2-4} hydroxyalkyl guar gum in the claimed amounts, wherein preferred guars include the claimed nonionic hydroxypropyl guar gum, see page 2, lines 17-17 and 25-27. Kao teaches that all direct dyes and mixtures thereof may be used in the claimed amounts, but preferred are cationic dyes including the claimed Basic Red 22, see page 2, line 32-56 (particularly line 50); page 3, lines 25-26, and Examples. The compositions may comprise aqueous/alcoholic mediums as claimed, and may have pH's as claimed, see page 2, lines 23-24, and page 4, lines 17-18. Note the examples, particularly example 1 which uses hydroxypropyl guar in combination with cationic dyes, and example 2 which uses a cationic hydroxypropyl guar in combination with a

basic red dye, wherein the compositions are applied to hair in a dyeing process as claimed. Kao Corp does not exemplify a composition which contains cationic dye as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair which contains Basic Red 22, additional direct dyes, and a modified guar gum thickener as claimed, wherein each component is present in the claimed mediums in the claimed amounts at the claimed pH's, and wherein the compositions are applied to hair in dyeing processes as claimed, because such compositions and processes fall within the preferred scope of Kao's teachings. Particularly, it would have been obvious to those skilled in the art to at least partially substitute the cationic dyes in Kao's examples with Basic Red 22 as claimed, resulting in dyeing compositions and processes as claimed, because the patentee teaches the equivalence between this claimed dye and the exemplified basic dyes as preferred for use in the patentee's compositions, absent a showing otherwise.

Claims 1-19, 25-31, 42-47 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang.

Lang, U.S. Patent No. 3,985,499, teaches dyes for hair which overlap in scope with those as claimed, see col. 1, line 34-col. 3, line 59. Preferred dyes include those of formula (IIA), see col. 9, line 1-col. 11, line 11. The patentee teaches that the dyes may be used in the claimed amounts in compositions which may also contain aqueous mediums and additional direct dyes, wherein the compositions may have pH's as claimed, and may be applied to hair in dyeing processes as claimed, see col. 13, lines 28-33 and 59-65; col. 15, lines 7-9; and col. 4, lines 22-26.

The compositions may also contain an oxidizing agent as claimed, see Examples 27-29 and K. Examples L, M and R contain polymers containing at least one sugar unit as claimed in the claimed amounts. Particularly note Examples K and L which contain the polymer hydroxyethyl propyl cellulose in an aqueous medium in the claimed amounts at the claimed pH's. These compositions contains dyes which differ from those of formula (I) as claimed only in that they contain an extra substituent on the pyridine ring, see Examples 50 and 51. Lang, however, teaches the equivalence between the exemplified substituents and hydrogen as preferred, see col. 10, lines 4-6. Lang also exemplifies various dyes as claimed, see e.g. Examples 47, 48, 52, 56 and 59. Lang does not exemplify a composition as claimed, particularly which contains both a polymer and dye as claimed. The patentee also does not teach the claimed dyeing methods wherein the oxidant is separately applied.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate compositions for dyeing hair which contain cationic dyes, hydroxyalkyl cellulose polymers, oxidants, and additional direct dyes in aqueous mediums at the claimed pH's, wherein each component is present is the claimed amounts, and is applied to hair in dyeing processes as claimed, because such compositions and processes fall within the scope of Lang's teachings. Particularly, it would have been obvious to those skilled in the art to substitute the structurally similar dyes (to those as claimed) of Examples K and L with dyes as claimed, resulting in dyeing compositions and processes as claimed, because Lang teaches the equivalence between such cationic dyes for use in the patentee's compositions, absent a showing otherwise. The Office

holds the position that the claimed processes are patentably indistinct from those taught by Lang because the same end results are obtained, i.e. the application of a cationic dye, polymer and oxidant to the hair, absent a showing otherwise.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that if any evidence is to be presented in accordance with 37 CFR 1.131 or 1.132, such evidence should be presented before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caroline Liott whose telephone number is (703) 305-3703. The examiner can normally be reached on Mondays-Thursdays from 8:30am to 6:00pm, and on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached at (703)308-4708. All before final official faxes should be sent to (703) 305-7718. All after final official faxes should be sent to (703) 305-3599. All non-official faxes should be sent to (703) 305-6078.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0661.

C.D.L.
September 11, 2000

Caroline D. Liott
CAROLINE D. LIOTT
PRIMARY EXAMINER